

## **REMARKS**

This amendment is being filed as a response to the Office Action of April 30, 2008.

Reconsideration is respectfully requested in view of these amendments and remarks.

### **Rejections under Section 112, Second Paragraph**

Claims 1-7 have been rejected under 35 USC 112, second paragraph. Applicant respectfully asserts that such rejections have been addressed by the amendments to Claims 1-3 submitted hereinabove.

### **Rejections under 35 USC § 103(a)**

Claims 1-7 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda (Japanese Publication No. JP 08-084855, herein referred to as '855'), in view of Toy Co. (Japanese Publication No. JP 04-352980, herein referred to as '980'). This rejection is respectfully traversed. Applicant respectfully requests reconsideration of these rejections in light of the amendments and arguments contained herein.

The dice game apparatus defined in present claim 1 includes a camera for photographing the dice. The Office has asserted that "'855 shows (1) a CCD camera used to photograph a dice agitator and dice when they come to rest" (page 2, last paragraph). Applicant respectfully disagrees. To better understand the teachings of the Japanese Patents cited by the Examiner as prior art, Applicant has used machine translations of such Japanese Patents provided by the Japanese Patent Office website. '855 does not use a camera to detect the spots shown on the dice, but rather electromagnetic fields, as seen in the following excerpt from '855:

[0030]The dice game machine 10 is provided with the projecting-eyes detection system which detects the projecting eyes of a dice in an instant. Therefore, if operation of a dice stops, this projecting-eyes detection system can detect the projecting eyes of a dice to the almost same timing as each player checks visually. "The reading system of the eye of die" for which these people applied and which was indicated in JP,5-177056,A is used for this projecting-eyes detection system. two or more transponders (a tag may be called) which approached each field of the dice, and were mainly boiled and embedded in it, and the transmission and reception coil constructed under the felt of the field 24 are used for this system. Each of this transponder has the memory measure which memorized beforehand the service number which displays the eye of the field which counters the field of that dice that approached, a conversion method which changes that service number into a corresponding specific electromagnetic wave signal, and a coil which sends that electromagnetic wave signal. If electromagnetic waves are sent from the transmission and reception coil provided under the field 24, according to it, the transponder of a dice will send the specific electromagnetic wave signal of each transponder according to the service number of a memory measure with the electric power of the electromagnetic wave. The portion which turned to the predetermined direction of the dice by detecting the specific electromagnetic wave signal sent from the transponder nearest to a transmission and reception coil among these specific electromagnetic wave signals via a transmission and reception coil is detected, The eye of a field corresponding to the portion which has turned to above in that case is judged. (JPTO machine translation of '855 - emphasis added).

Therefore, a system that uses transponders and electromagnetic wave signals does not teach a camera, as claimed by Applicant, because cameras use optical images and not electromagnetic signals. Furthermore, there is no teaching in '980 of using photography on the dice. Thus, the prior art does not suggest a camera for photographing the dice, as claimed by Applicant.

Further, the Office has provided only vague details on how the prior art teaches the aforementioned features, merely putting forward conclusory statements without articulated reasoning on how the prior art teaches the claimed features. The Office has merely cited claim language without any indication on how the references teach the claimed features. Applicant respectfully requests that the Office point out where each of the specific limitations recited in the rejected claims is found in the prior art relied on in the rejection without

mischaracterizing the references. See MPEP, “the examiner should set forth in the Office action ... (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate” (MPEP 706.02(j)-emphasis added).

Further, the Office has asserted that “to have used the agitator of ‘980 in place of the one shown by ‘855 would have been an obvious matter of choice in substituting one known device for that of another” (page 3, first paragraph). Applicant respectfully disagrees. First, changing the agitator in ‘855 would change its principle of operation, as ‘855 uses a shooting button 26 (see Figure 5, abstract) giving the shooter control of the amount of force used on the dice. Replacing the agitator in ‘855 with an air operated agitator as in ‘980 would render the shooting button 26 useless thereby changing the principle of operation of ‘855. Second, the agitator in ‘980 is designed for a small area (see Fig. 2). However, the dice rolling field 24 in ‘855 is a large area. Notice that there are several players around the dome 22. Adding a mechanism to blow air in the large rolling field 24 would be a complex matter, and therefore not obvious to one having ordinary skill in the art.

The Office has not articulated reasoning with rational underpinning to support the conclusion of obviousness. The Supreme Court in KSR noted that the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit, *In re KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. \_\_, 82 USPQ2d 1385 (2007). The Court in KSR quoted *In re Kahn*, which stated that “[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness” (emphasis added). The Office’s justification for the combination is “a matter of choice,” but the Office does not provide an explanation on why this cumbersome change would be justified. Thus, the Office

has merely put forth conclusory statements and not provided articulated reasoning to support the legal conclusion of obviousness.

The dice game apparatus defined in present claim 2 includes the feature that the rolling surface and the camera are shielded by a shielding member. The prior art does not teach a camera inside the shield, as previously discussed. Thus, the prior art does not suggest that the rolling surface and the camera are shielded by a shielding member, as claimed by Applicant.

Additionally, the dice game apparatus of present claims 2 and 6 include a shielding member. The Office has asserted that “16 [in ‘855] is considered a shielding member” (page 3, first paragraph). Applicant respectfully disagrees. ‘855 teaches an “illumination part 16 which extended horizontally from the screen part 14” (see paragraph [0023] of JPTO machine translation - emphasis added). Thus, a light source on top of the dome does not teach a shielding member because illumination part 16 never comes in contact with the dice and can not shield the dice from anything.

In view of the foregoing, the Office is requested to withdraw the rejection of claims 1, 2 and 6 under §103 for the reasons presented hereinabove. Dependent claims 2-7 are submitted to be patentable for at least the same reasons independent claim 1 is believed to be patentable. The Applicant therefore respectfully requests reconsideration and allowance of the pending claims. A Notice of Allowance is respectfully requested.

If the Examiner has any questions concerning the present amendment, the Examiner is kindly requested to contact the undersigned at (408) 774-6920. If any other fees are due in connection with filing this amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. SHIBP004).

Respectfully submitted,  
**MARTINE PENILLA & GENCARELLA, LLP**

/Jose M. Nunez/

Jose M. Nunez  
Reg. No. 59,979

710 Lakeway Drive, Suite 200  
Sunnyvale, CA 94085  
Telephone: (408) 749-6900  
Facsimile: (408) 749-6901  
**Customer Number 25920**